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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,349	10/21/2003	Jose B. Rivera	BCI-168US	4160
23122	7590	09/06/2007		
RATNERPRESTIA P O BOX 980 VALLEY FORGE, PA 19482-0980			EXAMINER FLETCHER III, WILLIAM P	
			ART UNIT 1762	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/690,349	Applicant(s) RIVERA ET AL.	
	Examiner William P. Fletcher III	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 22, 2007, has been entered.

Response to Amendment

2. Claims 1-30 remain pending.

Election/Restrictions

3. Claims 1-16 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 11, 2006.

Response to Arguments

4. Applicant's arguments filed June 22, 2007, have been fully considered but they are not persuasive.

A. Applicant argues that Rivera does not teach or suggest the use of his formulations on metals in general, but only on magnesium or magnesium alloys. The Examiner disagrees.

i. Rivera specifically discloses, as examples of the Mg alloy, AZ91 and AM60, both of which are aluminum-containing alloys. See Blum et al.,

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Materials Science and Engineering A319-321 (2001) 735-740, Table 1, as evidence of this fact. This teaching of Rivera meets the claimed limitations requiring an aluminum or aluminum alloy surface. Based upon this new reading of Rivera, Petrole is no longer necessary as a secondary reference in support of the rejection of claim 25. See the new grounds of rejection set forth below.

B. Applicant argues that the cited references teach the sequential and not the simultaneous application of organofunctional silanes and polymer blends in combination with a group IV-B element. This argument is not persuasive.

i. It is *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), which cites *In re Susi*, 169 USPQ 423, 426 (CCPA 1971) and *In re Crockett*, 126 USPQ 186, 188 (CCPA 1960). See also *Ex parte Quadranti*, 25 USPQ2d 1071 (BPAI 1992).

C. Applicant argued (01/08/2007) that there would have been no expectation of success in combining the two treatments of Rivera and that Applicant demonstrates an additive result when a diminished result would have been expected. The Examiner disagrees.

i. Contrary to Applicant's assertion, there is absolutely no evidence that a combination of treatments would have led to undesirable performance. The "failure" rating given by Rivera to Example 3 is described as "surprising" and

“anomalous” [7:16-22]. Such a conclusion is far from a conclusive indication disparaging the performance of Example 3.

ii. Applicant is reminded that references are part of the literature of the art, relevant for all they contain, and that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. See MPEP 2123. Further, Applicant is reminded that the expectation of success need only be reasonable, not absolute, and that the knowledge that an element would work for its intended purpose tends to show reasonable expectation of success using that element. See *Pfizer, Inc. v. Apotex, Inc.*, CAFC (2006-1261). Since Rivera broadly discloses a composition containing a group IV-B element and a polymer blend as effective, this “anomalous” result for a specific composition does not conclusively demonstrate that any and all such compositions, elsewhere taught as effective, are ineffective.

iii. Finally, Applicant is reminded that “[e]vidence showing there was no reasonable expectation of success may support a conclusion of non-obviousness.” See MPEP 2143.02. While Applicant has pointed out an anomalous, ineffective result for one specific composition, this observation is not evidence establishing that the combination of Rivera's organofunctional silane, group IV-B element, and polymer blend having –OH and –COOH functionalities would, necessarily, yield an ineffective result.

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E. Applicant argued (01/08/2007), with respect to claims 18-20, that the ratio of silane to polymer blend is not a result-effective variable. The Examiner disagrees.

i. What amount of polymer to add to a coating composition is the most basic question faced by the artisan. If the artisan cannot answer this question he or she cannot proceed. That the limitations of these claims occupy such a fundamental level of inquiry is evidence enough of their recognition as result-effective variables.

F. Finally, with respect to the double-patenting rejections, it is the Examiner's position that application of solutions separately is recited in Rivera's claims (specifically claims 1, 9, and 11). The Examiner does not rely on the body of Rivera at all. Nevertheless, Applicant is reminded that reference to the disclosure is, in fact, permissible. See pages 5-6 of the Office action mailed April 6, 2007. Even if Rivera's claims did not recite the compositional components, it would still be proper to refer to Rivera's reference as the basis for selecting the compositions taught as operative. The basis for holding the combination obvious is the same as that determined by the courts, which clearly and unambiguously explains the presence of the "prior art" language.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al. (US 6,126,997 A) in view of Blum et al. (Materials Science and Engineering A319-321 (2001) 735-740).**

A. This reference teaches all of Applicant's claimed limitations except that the substrate is treated *either* with an organofunctional silane *or* a group IV-B element and a polymer blend having a plurality of carboxylic functional groups and a plurality of hydroxyl groups [abstract; 5:1-40; and claim 11]. Rivera specifically discloses, as examples of the Mg alloy, AZ91 and AM60, both of which are aluminum-containing alloys. See Blum et al., Materials Science and Engineering A319-321 (2001) 735-740, Table 1, cited solely as evidence of this fact. This teaching of Rivera meets the claimed limitations requiring an aluminum or aluminum alloy surface.

B. It is *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third

composition which is used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), which cites *In re Susi*, 169 USPQ 423, 426 (CCPA 1971) and *In re Crockett*, 126 USPQ 186, 188 (CCPA 1960). See also *Ex parte Quadranti*, 25 USPQ2d 1071 (BPAI 1992).

C. With specific respect to claims 18-20, it is the Examiner's position that the ratio of silane to polymer blend is a result-effective variable, effecting various properties of the composition including viscosity, cross-linking density, etc. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Rivera so as to optimize this result-effective variable by routine experimentation, absent evidence of criticality. See MPEP 2144.05.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. **Claims 17-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-15 of U.S. Patent No. 6,126,997 A in view of Blum et al. (Materials Science and Engineering A319-321 (2001) 735-740).**

A. Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant claims fully encompass the subject matter of the co-pending claims except that, in the co-pending claims, the substrate is treated with *either* an organofunctional silane *or* a group IV-B element and a polymer blend having a plurality of carboxylic functional groups and a plurality of hydroxyl groups [abstract; 5:1-40; claim 11]. As noted above, Blum is evidence of the fact that the '997 patent teaches aluminum and/or aluminum alloy.

B. It is *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), which cites *In re Susi*, 169 USPQ 423, 426 (CCPA 1971) and *In re Crockett*, 126 USPQ 186, 188 (CCPA 1960). See also *Ex parte Quadranti*, 25 USPQ2d 1071 (BPAI 1992).

Conclusion

10. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner

August 30, 2007